

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 5-13, 15, and 17 remain pending. In this Reply, Applicant has amended claims 5 and 13.

Reasons for Entry of Amendments

Applicant respectfully requests entry of the amendments presented herein, which are merely editorial in nature and do not affect claim scope. Such amendments clearly do not raise issues requiring further consideration and/or search.

Prior Art Rejections

1. **Catanzaro**

Claims 13, 15, and 17 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated by Catanzaro et al. (U.S. Patent 5,502,727). This rejection is respectfully traversed.

Claim 13 recites a combination of features in an image communication system in which an image processing apparatus and a portable phone can communicate data with each other and the portable phone sets a print mode to produce a printout of an image by a printer, the features including an image data converting device for converting, when the print mode is set by the portable phone, image data into data suitable for an output format of the

printer.

In rejecting claim 13, the Office Action cites Col. 2, line 65 - Col. 3, line 5 of *Catanzaro*. This cited portion of *Catanzaro* provides that enhanced phone 105 can provide a hard copy of a displayed image. In view of this portion, the Office Action states that it is inherent that the image processing apparatus converts the image into a printable format since the phone prints out the image in a printing mode. The Applicant respectfully disagrees that this reasoning establishes anticipation of any pending claim.

At the outset, the Applicant notes that the language of the Office Action does not correspond to a recitation of any portion of claim 13. Particularly, claim 13 recites "an image data converting device for converting, when the print mode is set by the portable phone, image data into data suitable for an output format of the printer". By contrast, the Office Action states that "it is inherent that the image processing apparatus converts the image into a printable format". In other words, the rejection does not correspond to the feature of "an image data converting device for converting" as recited in claim 13. Therefore, only for the sake of argument, the Applicant assumes that the Office Action is alluding to the image data converting device when it provides that it is inherent that an image processing apparatus converts the image into a printable form.

Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

To support the inherency position, the Office Action asserts that a camera 106 of Catanzaro is an image processing apparatus and that enhanced phones (101 and 105) of Catanzaro are portable phones. Applying the "doctrine" to Catanzaro, the missing element is converting the image into a printable format and the thing described is the image processing apparatus (image data converting device). Since Catanzaro is silent as to whether the enhanced phones (101 or 105) or the camera 106 converts an image into a printable format, the issue then, for purposes of determining inherency, is whether it is necessary that converting the image

into a printable format (the missing element) is performed by the thing described (camera 106).

In this regard, it is quite apparent that the Office Action's own assertion works against itself. In other words, since the Office Action states that enhanced phone 105 converts an image into a printable format, it is obvious that it is not necessary that the thing described (camera 106) convert the image into a printable format.

Obviously, it is within the realm of possibility that the camera 106 can convert the image into a printable format. However, since Catanzaro assigns the function of providing a hard copy to enhanced phone 105, it is not even probable that camera 106 converts an image into a printable format. It is only possible. Therefore, the inherency position fails under the "doctrine of inherency".

Still further, in the Applicant's claimed invention, it is clear that a portable phone sets a print mode. In response to the setting of a print mode, an image converting device included in the image processing apparatus converts image data into data suitable for an output format of the printer.

By contrast, Catanzaro is not clear as to how a print mode is set. Rather, Catanzaro is silent with regard to which device sets the print mode, which device converts the image data into data

suitable for an output format of the printer, and the order in which these events occur. Therefore, the rejection under 35 U.S.C. 102 is improper.

At least in view of the discussion provided above, Applicant respectfully submits that the asserted grounds of rejection fail to establish anticipation of claim 13. Claims 15 and 17 recite features similar to the features recited in claim 13, and therefore, the asserted grounds of rejection fail to establish anticipation of claim 15 or claim 17 based on similar reasoning.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

The Applicant has previously requested (if this grounds of rejection is maintained) that the Examiner provide objective evidence to support any assertions of inherency. See MPEP § 2112. It is the Applicant's view that such objective evidence has not been provided. Therefore, if this grounds of rejection is still maintained, Applicant again respectfully requests that the Examiner provide objective evidence to support any assertions of inherency.

2. Fukuoka - Sacca

Claims 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* (U.S. Patent 6,104,430)

in view of Sacca (U.S. Patent 6,380,967). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Claim 5

Claim 5 (like claims 6, 8, and 9) sets forth an image processing apparatus which includes: an instruction receiving device for receiving the image data reduction instruction sent from the first portable phone; a data quantity reducing device for reducing a data quantity of image data according to the image data reduction instruction received by the instruction receiving device; and a first image data transmitting device for transmitting, to the first portable phone, the image data of which the data quantity is reduced by the data quantity reducing device.

In rejecting claim 5, the Office Action cites col. 10, line 65 - col. 11, line 18 of the secondary reference, Sacca, as allegedly teaching the claimed reduction ratio receiving device and reduction ratio transmitting device features. Applicant notes, however, that the cited portions of Sacca merely disclose that a video fax 100 automatically grabs an image from video camera 102, and sends it at low or high resolution so that the user can select between low and high resolutions, as set forth in the portion of Sacca provided below:

To use videofax 100, a user sits in front of video camera 102 while conversing on the telephone and looks at TV monitor 106. The user presses and holds down the GRAB key to display on TV monitor 106 the motion picture captured by video camera 102. When a desirable image is displayed, the user releases the GRAB key and the specific image is stored in videofax 100 and displayed on TV monitor 106.

If the user is not satisfied with the image, they can repeat the process indefinitely and grab and store a new image (which overwrites the previous image) until satisfied with the choice.

After the image is selected, the user advises the other party on the telephone line that an image is about to be transmitted, and then presses the SEND HI or SEND LO key to initiate a video image transfer at either high or low resolution, respectively.

Sacca, Col.9, lines 36-45

The position set forth in the Office Action is problematic for reasons similar to reasons the Applicant provided with respect to claim 13. That is, the references cited in the Office Action make no distinction as to where (or by what device in the system) image data is formatted, or with respect to claim 5, where (or by what device in the system) image data is reduced.

For example, assume (only for the sake of argument) that videofax 100 of Sacca initiates a video image transfer at either high or low resolution as asserted by the Office Action. Further assume (only for the sake of argument) that the asserted transfer of data at a specific resolution equates with data reduction. Even with these assumptions, a huge deficiency still remains. This is

because videofax 100 (which the Office Action has equated with a first portable phone) does not send any instructions to an image processing apparatus (for example, a camera).

The Office Action has equated the Applicant's claimed image processing apparatus with video camera 102 of *Sacca* (see *Sacca*, Col.10, line 65 - Col.11, line 18). Clearly, camera 102 of *Sacca* receives no data reduction instruction from the asserted first portable phone of *Sacca* (videofax 100). As such, the system of *Sacca* has the same disadvantages of a conventional system. One such disadvantage is that the image processing apparatus of *Sacca* is not capable of reducing data based on an instruction, and then providing that data to a first portable phone, the data having been reduced as instructed.

Accordingly, the cited secondary reference fails to disclose or suggest the above-detailed claim features relating to a data reduction instruction.

At least for this reason, the asserted combination of *Fukuoka* and *Sacca* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 5. The asserted grounds of rejection fail to establish *prima facie* obviousness of claim 6, 8 and 9 based on similar reasoning.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka* and *Sacca*.

3. *Fukuoka - Sacca - Catanzaro*

Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Catanzaro*. This rejection is respectfully traversed.

Like claims 5, 6, 8 and 9 (argued above with respect to *Fukuoka* and *Sacca*), claims 7, 11 and 12 set forth an image processing apparatus which includes an instruction receiving device for receiving the image data reduction instruction sent from the first portable phone; a data quantity reducing device for reducing a data quantity of image data according to the image data reduction instruction received by the instruction receiving device; and a first image data transmitting device for transmitting, to the first portable phone, the image data of which the data quantity is reduced by the data quantity reducing device.

The asserted combination of *Fukuoka* and *Sacca* (argued above) fails to establish *prima facie* obviousness of claims 5, 6, 8 and 9. Therefore, the combination of *Fukuoka* and *Sacca* fail to establish

prima facie obviousness of claim 7, 11 and 12 based on similar reasoning. Catanzaro cannot supply the deficiency of *Fukuoka* and *Sacca*.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka*, *Sacca* and *Catanzaro*.

4. *Fukuoka - Sacca - Shiohara*

Claim 10 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Shiohara* (U.S. Patent 6,618,553). This rejection is respectfully traversed.

Like claims 5, 6, 8 and 9 (argued above with respect to *Fukuoka* and *Sacca*), claim 10 sets forth an image processing apparatus which includes an instruction receiving device for receiving the image data reduction instruction sent from the first portable phone; a data quantity reducing device for reducing a data quantity of image data according to the image data reduction instruction received by the instruction receiving device; and a first image data transmitting device for transmitting, to the first portable phone, the image data of which the data quantity is reduced by the data quantity reducing device.

The asserted combination of *Fukuoka* and *Sacca* (argued above) fails to establish *prima facie* obviousness of claims 5, 6, 8 and 9. Claim 10 recites a combination of features similar to the combinations of features recited in claims 5, 6, 8 and 9, and therefore the combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 10 based on similar reasoning. *Shiohara* cannot supply the deficiency of *Fukuoka* and *Sacca*.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka*, *Sacca*, and *Shiohara*.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$120 is being filed concurrently herewith.

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Art Unit: 2615


Reply to Office Action of November 17, 2004

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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